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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,130	07/02/2003	Franz Maser	HERR 20.480	7178
26304	7590	02/10/2005		
KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK, NY 10022-2585			EXAMINER KUHN, SARAH LOUISE	
			ART UNIT	PAPER NUMBER
			1761	
DATE MAILED: 02/10/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/613,130	Applicant(s) MASER ET AL.	
	Examiner Sarah L Kuhns	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: The pH values should be written with decimal points instead of commas. Also, on page 8, at lines 14 and 15, and page 10, at lines 5 and 6, "propylene" and "butylene" are misspelled.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 23 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 23 appears to be a duplicate of claim 1. Further, the claim fails to further limit the claim upon which it depends.

Claim 27 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear as to what this claim is meant to depend on. The claim appears to depend on more than one claim. It is suggested that the claim be drafted in accordance with the U.S. patent practice.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 26 provides for the use of ^Pn edible film, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 26 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-15, 17-20, 23, 24, 26, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Forrest, WO 94/22315.

In regard to claims 1, 2, 4, 5, 20, and 23, Forrest discloses a removable edible label based on collagen for labeling food products, the label being free of any adhesive layer (abstract), being able to stick to the food product throughout the slaughter process until packaging and being able to be removed intact from the food product whenever desired, characterized in that the said label has a swelling rate in water between 275% and 350% (page 7, table) and pH value between 4 and 7 (page 6, lines 1-4).

In regard to claims 6, 8-11, 14, and 15, Forrest discloses the label further comprising a polyol, modified cellulose, or charge/uncharged polysaccharides (claim 4). Forrest also discloses the label comprising food grade dyes, such as carminic acid, annatto, and sunset yellow (page 6, lines 15-20).

In regard to claim 7, Forrest discloses the label comprising glycerol (claim 5).

In regard to claims 12 and 13, Forrest does not disclose the label comprising a non-collagenous protein and therefore teaches a label with 0% non-collagenous proteins which is within applicant's claimed range.

In regard to claim 17, Forrest discloses the label having a thickness of 15-50 microns (page 4, lines 17-22).

In regard to claims 18 and 27, Forrest discloses the label having written information and graphics that have been either hand-written or printed by means such as an ink jet printer (page 6, lines 21-26).

In regard to claim 19, Forrest discloses the use of edible ink (page 6, lines 15-20).

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In regard to claims 24, Forrest discloses a process for preparing an edible film characterized in that the collagen gel is extruded in to a flat film, that may be crosslinked according to any method known in the art (page 3, lines 5-6), so that the swelling rate in water of the film is between 120 and 450% and that the pH of the film is controlled so it shows a value between 4 and 7 (example 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3, 16, 21, 22, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forrest.

In regard to claims 3, 21, and 22, Forrest discloses a collagen-based label (abstract), but does not disclose a swelling rate of between 120% and 270%. However, Forrest does teach that swelling rate decreases as pH increases and that adhesion correlates with ability absorb moisture (example 1). It would therefore have been expected that a label with a pH in the upper part of the range claimed by applicant would have a swelling rate in the claimed range and it would have been obvious to make a label with such a swelling rate in order to provide a label that adhered to meat, yet could still be easily removed intact.

In regard to claim 16, Forrest does not specify a width of the label. However, it would have been obvious to one of ordinary skill in the art to modify the width of the label based on the specific product it was being used for and the amount of information that was desired to be contained thereon.

In regard to claim 25, Forrest does not explicitly state that the film is cut; however it would be expected that the film was cut to the desired label size and would have been obvious to do so to fit the specific requirements of different products.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah L. Kuhns whose telephone number is 571-272-1088. The examiner can normally be reached on Monday-Friday from 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLK


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